

REMARKS

Claims 1-3 and 5-14 are pending. Claims 1, 3, and 5-7 have been amended. Claim 4 has been canceled. No new matter has been introduced. Reexamination and reconsideration of the application are respectfully requested.

In the January 11, 2008 Office Action, the Examiner rejected claims 1-12 under 35 U.S.C. §103(a) as being unpatentable over Maruyama et al., U.S. Patent No. 6,560,407 B2 (hereinafter Maruyama) and further in view of Anderson et al., U.S. Patent Application Publication No. 20030194214 (hereinafter Anderson). The Examiner rejected claims 13 and 14 under 35 U.S.C. §103(a) as being unpatentable over Maruyama in view of Anderson and further in view of Honda et al., U.S. Patent No. 7,015,939 B2. (hereinafter Honda). Applicant respectfully traverses the rejections in view of the claims, as amended.

Independent claim 1, as amended recites:

1. A method of controlling an operation of an optical disc recording apparatus operable for recording record information onto an optical disc and forming an image corresponding to image information on the optical disc, the method comprising: determining an operation of recording the record information by the optical disc recording apparatus and an operation of forming the image corresponding to the image information by the optical disc recording apparatus;

displaying, on a display, optical disc information reflecting the record information and the image which are determined by the user, wherein the optical disc information includes a preview display reflecting the determined record information and the determined imaged; and

giving instructions for starting recording of the record information and instructions for starting formation of the image corresponding to the image information to the optical disc recording apparatus after the determining step, wherein the record information is recorded and the image is formed on a recording face of the optical disc by applying a laser beam.

The Maruyama reference does not disclose, teach, or suggest the method specified in independent claim 1, as amended. As the Examiner has acknowledged, "Maruyama et al. fails to teach the recording information is recorded and the image is formed on the same side of the optical disc by applying a laser beam." (*January 11 Office Action, page 3*) Therefore, the Maruyama reference also does not disclose a method wherein "giving instructions for starting recording of the record information and instructions for starting formation of the image corresponding to the image information to the optical disc recording apparatus after the determining step, wherein the record information is recorded and the image is formed on a recording face of the optical disc by applying a laser beam".

The Maruyama reference also fails to disclose "***displaying, on a display, optical disc information reflecting the record information and the image which are determined by the user, wherein the optical disc information includes a preview display reflecting the determined record information and the determined imaged.***"

The Anderson reference does not make up for the deficiencies of Maruyama. The Anderson reference discloses markings representative of a title or filename may be with a laser to either a data side or a label side of an optical disc. However, the combination of Maruyama and Anderson fails to disclose, teach, or suggest "giving instructions for starting recording of the record information and instructions for starting formation of the image corresponding to the image information to the optical disc recording apparatus after the determining step, wherein the record information is recorded and the image

is formed on a recording face of the optical disc by applying a laser beam”
and “displaying, on a display, optical disc information reflecting the record
information and the image which are determined by the user, wherein the
optical disc information includes a preview display reflecting the
determined record information and the determined imaged.” Accordingly,
Applicant respectfully submits that independent claim 1, as amended
distinguishes over Maruyama in combination with Anderson.

Independent claims 3 and 6 recite limitations similar to those in
independent claim 1, as amended. Accordingly, Applicant respectfully submits
that claims 3 and 6 distinguish over Maruyama in combination with Anderson for
reasons similar to those set forth above with respect to independent claim 1, as
amended.

Claims 2, 5 and 7-14 depends from independent claims 1, 3 and 6,
respectively. Accordingly, Applicant respectfully submits that claims 2, 5 and 7-
14 distinguish over Maruyama in combination with Anderson for the same
reasons set forth above with respect to independent claims 1, 3 and 6,
respectively.

With respect to claims 13 and 14, Applicant respectfully submits that the
rejection under §103 is improper. Section 103(c) provides:

Subject matter developed by another person, which qualifies as prior art
only under one or more subsections (e), (f), and (g) of section 102 of this
title, *shall not preclude patentability under this section where the subject*
matter and the claimed invention were, at the time the claimed invention
was made, owned by the same person or subject to an obligation of
assignment to the same person. 35 U.S.C. § 103 (c) (emphasis added)

As noted above, the Examiner rejected claim 13 and 14 under 35 U.S.C. § 103

(a) as being unpatentable over as being unpatentable over Maruyama in view of Anderson and further in view of Honda et al., U.S. Patent No. 7,015,939 B2. (hereinafter Honda). (*January 11 Office Action, pages 6 and 7*)

However, the Honda reference is prior art only under 102(e) and both the Honda reference and the present application are assigned to Yamaha Corporation and thus, are commonly owned. Therefore, in accordance with § 103(c), the Honda reference may not be used to preclude patentability under section 103. Accordingly, Applicant respectfully submits that the rejection of claims 13 and 14 under § 103(a) should be withdrawn.

Even assuming *arguendo* that the rejection of claims 13 and 14 under § 103 (a) is proper, the combination of Maruyama, Anderson and Honda fails to disclose, teach, or suggest “giving instructions for starting recording of the record information and instructions for starting formation of the image corresponding to the image information to the optical disc recording apparatus after the determining step, wherein the record information is recorded and the image is formed on a recording face of the optical disc by applying a laser beam” and “displaying, on a display, optical disc information reflecting the record information and the image which are determined by the user, wherein the optical disc information includes a preview display reflecting the determined record information and the determined imaged.” Accordingly, Applicant respectfully submits that claims 13 and 14 distinguish over Maruyama in combination with Anderson and Honda.

Applicant believes that the foregoing amendment and remarks place the application in condition for allowance, and a favorable action is respectfully requested. If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles telephone number (213) 488-7100 to discuss the steps necessary for placing the application in condition for allowance should the examiner believe that such a telephone conference would advance prosecution of the application.

Respectfully submitted,

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